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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/587,196	01/23/2007	Yoshiyuki Kono	Q95815	8443
23373 7590 09/21/2010 SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037				
EXAMINER MOORE, MARGARET G				
ART UNIT		PAPER NUMBER		
1796				
NOTIFICATION DATE		DELIVERY MODE		
09/21/2010		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

sughrue@sughrue.com  
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### Office Action Summary

**Application No.**

10/587,196

**Applicant(s)**

KONO, YOSHIYUKI

**Examiner**

Margaret G. Moore

**Art Unit**

1796

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 July 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 to 4, 6, 7, 9, 11, 12, 16-18, 20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 to 4, 6, 7, 9, 11, 12, 16-18, 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/06)  
Paper No(s)/Mail Date 9/7/10, 5/21/10
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

1. Applicants' amendment overcomes the previous rejections; however applicants have cited a new reference in the IDS dated 9/7/2010 of relevance. Please see the new ground of rejection below. As such this office action cannot be made final. The Examiner appreciates applicants' submission of this reference and its English language translation.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 to 4, 6, 7, 9, 11, 12 16 to 18 and 20 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP 2003 313302, herein '302.

'302 teaches a curable composition that contains a vinyl polymer having silyl crosslinkable groups and a polyether polymer (II) having less than 1.2 silyl groups. This polymer corresponds to the claimed polymer (B). As can be seen from the teachings starting on page 20 of 44, paragraph 119 and on, the composition can also contain a polyether polymer (III) having greater than 1.2 silyl groups. By having greater than 1.2 silyl groups, on average, at least some of the polyethers will have at least 2 silyl groups. This corresponds to a polyether having reactive silyl group and corresponds to claimed component (A). The preferred molecular weight ranges for the two polyether polymers are such that they anticipate the claimed limitation that (B) be lower than (A) by not less than 3,000. These two polyether anticipate the claimed curable composition.

Of particular note, please see Table 3 in which polyether P15 having a molecular weight of 3000 is admixed with a polyether P17 having a molecular weight of 16000. The polyether having a molecular weight of 3000 has 1 trimethoxysilyl group and meets the polyether (B) in claims 1, 3, 4, 6 and 7. The polyether having a molecular weight of 16000 has 1.6 silyl groups. This differs from the claimed polymer (A) in claims 1 and 9 only in that it has a corresponding "a" value of 2 rather than a silyl group of formula (1) in which a is 3.

In view of the very limited selection of silyl terminal groups disclosed by '302 (in which only "a" values of 2 and 3 are disclosed) one having ordinary skill in the art would have immediately envisioned a terminal silyl group having 3 hydrolyzable groups for the polymer P17 and in this manner the teachings of '302 anticipate that claimed.

In the alternative, if not anticipated then one having ordinary skill in the art would have found the selection of a silyl terminal group having 3 hydrolyzable groups rather than the silyl terminal group having 2 hydrolyzable groups to have been obvious.

For claim 2 please note that polymer P16 has .9 silyl groups and a corresponding "a" value of 2. This meets polymer (B) in claim 2. This also meets the requirement of claims 11 and 12. Note that the term "substantially" in "substantially one" gives this limitation some breadth such that .9 meets this requirement in claim 16.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday and Wednesday to Friday, 10am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Margaret G. Moore/  
Primary Examiner, Art Unit 1796

mgm  
9/14/10